

REMARKS

In the Office Action the Examiner noted that claims 1-9, 11-24, 35, 36, and 41-94 are pending in the application. The independent claims are 1, 35, 41, 45, 65-66, 84, and 92-93.

Claims 2, 46 and 67 have been canceled without prejudice to or disclaimer of the subject matter recited therein.

Claims 1, 3, 6, 9, 35, 41, 43-45, 47-49, 61, 62, 65, 66, 68-70, 82, 88, 91, 92 have been amended.

Applicant thanks the Examiner for indicating that claims 17, 18, 20, 22, 55-57, 76, 77, 79, 81 and 83 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, new claims 95-106 have been added and correspond to these claims in allowable form.

No new matter is believed to have been added.

CLAIM REJECTIONS UNDER 35 USC §102

IN ITEMS 2-4 ON PAGES 2-5 OF THE OFFICE ACTION, THE EXAMINER REJECTED CLAIMS 1, 5, 7, 8, 11, 15, 16, 35 AND 36 UNDER 35 U.S.C. §102(E) AS BEING ANTICIPATED BY VERBAKEL ET AL. (U.S. PATENT NO. 6,370,090).

Claim 1, as amended, of the present application recites:

An optical recording medium comprising: a read-only storage area; a non-magnetic writable storage area; a read-only lead-in area having first control information for both the read-only and non-magnetic writable storage areas; and a non-magnetic writable lead-in area having second control information relating to the non-magnetic writable storage area, wherein: the read-only storage area comprises the read-only lead-in area, a read-only memory (ROM) data area, and a read-only lead-out area; and the non-magnetic writable storage area comprises the non-magnetic writable lead-in area which comprises a connection zone formed of a non-storage reflective layer to connect the read-only storage area and the non-magnetic writable storage area, a random access memory (RAM) data area, and a read-only lead-out area.

In order for a reference to anticipate a claim, the reference must teach each and every element of the claim (MPEP §2131). Verbakel discloses "an audio management system to allow a user to access various audio track areas in a fast and easy manner" (Column 1, Lines 32-35). This system allows a file system or Master Table of Contents (TOC) to contain information about sub-TOC's that contain information about different audio tracks, such as two channel stereo data or higher multiples (5-6) of channel data (Column 4, Lines 48-58). However, Verbakel does not disclose a **non-storage reflective layer** to connect the read-

only storage area and the non-magnetic writable storage area. (Emphasis added). TOC-1 of Verbakel is a storage area used to store information about various audio tracks. Therefore, since Verbakel does not teach the features recited in independent claim 1, as stated above, it is respectfully submitted that claim 1 patentably distinguishes over Verbakel, and withdrawal of the §102(e) rejection is earnestly and respectfully solicited.

Claims 5, 7, 8, 11, 15, and 16 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by Verbakel. Therefore, it is respectfully submitted that claims 5, 7, 8, 11, 15, and 16 also patentably distinguish over Verbakel.

The Applicant respectfully submits that claim 35 also patentably distinguishes over Verbakel based at least on recitation of a similar connection zone that is a mirror zone connecting the read-only and rewritable areas. Verbakel does not teach or suggest any such zone.

Claim 36 depends from claim 35 and includes all of the features of that claim plus additional features which are not taught or suggested by Verbakel. Therefore, it is respectfully submitted that claim 36 also patentably distinguishes over Verbakel.

IN ITEM 5 ON PAGE 6 THE EXAMINER REJECTED CLAIMS 41 AND 42 UNDER 35 U.S.C. §102(E) AS BEING ANTICIPATED BY VERBAKEL.

Claim 41 of the present application recites "a read-only storage area having a lead-in area and a data area; and a non-magnetic writable storage area having a lead-in area including a non-storage connection zone which connects the read-only storage area and the non-magnetic writable storage area and a data area, wherein the lead-in area of read-only storage area comprises physical format information for the read-only storage area and the non-magnetic writable storage." As discussed earlier in this response, Verbakel does not disclose a non-storage connection zone. Therefore, the Applicant respectfully submits that claim 41 also patentably distinguishes over Verbakel.

Claim 42 depends from claim 41 and includes all of the features of that claim plus additional features which are not taught or suggested by Verbakel. Therefore, it is respectfully submitted that claim 42 also patentably distinguishes over Verbakel.

IN ITEMS 6-7 ON PAGES 7-10 THE EXAMINER REJECTED CLAIMS 45, 46, 48, 51-54, 63, 64, 66-68, AND 72-75 UNDER 35 U.S.C. §102(E) AS BEING ANTICIPATED BY VERBAKEL.

Claim 45 of the present application recites a non-magnetic writable storage area having second control information which includes a non-storage connection zone formed of a

reflective layer to connect the read-only storage area and the non-magnetic writable storage area. As stated previously in this response, Verbakel does not disclose a recording medium with these features, and similarly does not disclose an apparatus equipped with such a system controller such as recited in claim 45. Therefore, the Applicant respectfully submits that claim 45 also patentably distinguishes over Verbakel.

Claims 48, 51-54, and 63-64 depend from claim 45 and include all of the features of that claim plus additional features which are not taught or suggested by Verbakel. Therefore, it is respectfully submitted that claims 48, 51-54, and 63-64 also patentably distinguish over Verbakel.

Claim 66 of the present application recites a method of recording and reproducing data onto/from an optical recording medium including "recording the first control information in the lead-in area of the read-only storage area and recording the second control information in a lead-in area of the non-magnetic writable storage area, **the second control information including a non-storage connection zone formed of a reflective layer** to connect the read-only storage area and the non-magnetic writable storage area." As stated previously in this response, Verbakel does not disclose a recording medium with these features, and similarly does not disclose a method of recording/reproducing data that generates information applicable to this recording medium. Therefore, the Applicant respectfully submits that claim 66 also patentably distinguishes over Verbakel.

Claims 68 and 72-75 depend from claim 66 and include all of the features of that claim plus additional features which are not taught or suggested by Verbakel. Therefore, it is respectfully submitted that claims 68 and 72-75 also patentably distinguish over Verbakel.

IN ITEM 8 ON PAGE 11 THE EXAMINER REJECTED CLAIM 65 UNDER 35 U.S.C. §102(E) AS BEING ANTICIPATED BY VERBAKEL.

Claim 65 of the present application recites "a system controller which controls a reference linear velocity of the reproducing unit for reproduction of the data in the read-only storage area to be the same as a reference linear velocity for reproduction of the data in an innermost part of the non-magnetic writable storage area, wherein the non-magnetic writable storage area includes **a connection zone formed of a non-storage reflective layer** to couple the read-only storage area and the non-magnetic writable storage area." As stated previously in this response, Verbakel does not disclose a recording medium with these features, and similarly does not disclose an apparatus equipped with such a reproducing unit or system controller such as recited in claim 65. Therefore, the Applicant respectfully submits that claim 65 patentably distinguishes over Verbakel.

IN ITEM 9 ON PAGES 12-13 THE EXAMINER REJECTED CLAIMS 84-87 AND 90 UNDER 35 U.S.C. §102(E) AS BEING ANTICIPATED BY VERBAKEL.

Claim 84 of the present application recites a method including "reading data from the read-only and non-magnetic writable storage areas based upon the identification information, wherein the non-magnetic writable storage area includes a non-storage connection zone formed of a reflective layer to connect the read-only storage area and the non-magnetic writable storage area." As stated previously in this response, Verbakel does not disclose a recording medium with these features, and similarly does not disclose a method of reproducing data from this recording medium. Therefore, the Applicant respectfully submits that claim 84 also patentably distinguishes over Verbakel.

Claims 85-87 and 90 depend from claim 84. Therefore, it is respectfully submitted that claims 85-87 and 90 also patentably distinguish over Verbakel.

IN ITEM 10 ON PAGE 14 THE EXAMINER REJECTED CLAIM 92 UNDER 35 U.S.C. §102(E) AS BEING ANTICIPATED BY VERBAKEL.

Claim 92 of the present application recites a method of controlling an optical recording medium having a read-only area in an inner part and a non-magnetic writable area in an outer part of the optical recording medium, including "reproducing data from the read-only storage area and the non-magnetic writable storage area; and controlling a reference linear velocity for reproduction of the data in the read-only storage area to be the same as a reference linear velocity for recording or reproduction of the data in an innermost part of the non-magnetic writable storage area, wherein the non-magnetic writable storage area includes a connection zone formed of a non-storage reflective layer to couple the read-only storage area and the non-magnetic writable storage area." Verbakel does not disclose an optical recording medium having a read-only area in an inner part and a non-magnetic writable area such as this connected by a non-storage reflective layer, nor a method of reading and controlling the information contained thereon. Therefore, the Applicant respectfully submits that claim 92 also patentably distinguishes over Verbakel.

CLAIM REJECTIONS UNDER 35 USC §103

IN ITEM 12 ON PAGES 15-17 THE EXAMINER REJECTED CLAIMS 2, 3 AND 9 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL IN VIEW OF KOZUKA ET AL. (U.S. PATENT NO. 6,466,735).

As discussed in the previous section, claim 1 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Kozuka. Verbakel and Kozuka, either

alone or in any proper combination, do not teach or suggest at least the non-storage connection zone as recited in claim 1. Claims 3 and 9 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. For a proper §103 rejection, the cited references must properly combine to teach all of the features of the application at issue. Therefore, it is respectfully submitted that claims 3 and 9 patentably distinguish over the cited references, and withdrawal of the §103 rejection is requested.

IN ITEM 13 ON PAGES 17-18 THE EXAMINER REJECTED CLAIMS 4, 6, 19, AND 21 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL IN VIEW OF KOZUKA.

As discussed in the previous section, claim 1 patentably distinguishes over Verbakel. Further, Verbakel and Kozuka, either alone or in any proper combination, do not teach or suggest at least the non-storage connection zone as recited in claim 1. Claims 4, 6, 19, and 21 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 4, 6, 19, and 21 also patentably distinguish over the cited references.

IN ITEM 14 ON PAGE 19 THE EXAMINER REJECTED CLAIMS 12 AND 13 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL IN VIEW OF KOZUKA.

As discussed in the previous section, claim 1 patentably distinguishes over Verbakel. Further, Verbakel and Kozuka, either alone or in any proper combination, do not teach or suggest at least the non-storage connection zone as recited in claim 1. Claims 12 and 13 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 12 and 13 also patentably distinguish over the cited references.

IN ITEM 15 ON PAGE 20 OF THE OFFICE ACTION THE EXAMINER REJECTED CLAIM 14 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL.

As discussed in the previous section, claim 1 patentably distinguishes over Verbakel. Further, Verbakel and Kozuka, either alone or in any proper combination, do not teach or suggest at least the non-storage connection zone as recited in claim 1. Claim 14 depends from claim 1 and includes all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claim 14 also patentably distinguishes over the cited references.

IN ITEM 16 ON PAGES 21-22, THE EXAMINER REJECTED CLAIMS 58 AND 59 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL IN VIEW OF

KOZUKA.

As discussed in the previous section, claim 45 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Kozuka. Specifically, Verbakel, either alone or in any proper combination with Kozuka, does not teach or suggest at least a non-storage connection zone formed of a reflective layer. Claims 58 and 59 depend from claim 45 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 58 and 59 also patentably distinguish over the cited references.

IN ITEM 17 ON PAGES 23-24 OF THE OFFICE ACTION THE EXAMINER REJECTED CLAIMS 23 AND 24 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL IN VIEW OF MINE (U.S. PATENT 6,243,338).

As discussed in the previous section, claim 1 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Mine. Claims 23 and 24 depend from claim 1 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 23 and 24 also patentably distinguish over the cited references.

IN ITEM 18 ON PAGES 24-25 THE EXAMINER REJECTED CLAIMS 43 AND 44 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL IN VIEW OF KOZUKA AND MINE.

As discussed in the previous section, claim 41 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Kozuka and/or Mine. Claims 43 and 44 depend from claim 41 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 43 and 44 also patentably distinguish over the cited references.

IN ITEMS 19-20 ON PAGES 26-27 OF THE OFFICE ACTION THE EXAMINER REJECTED CLAIMS 47, 49, 61, 62, 70, 82, 88, AND 91 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL IN VIEW OF MINE.

As discussed above in the arguments for patentability under 35 USC §102, claim 45 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Mine. Claims 47, 49, 61, and 62 depend from claim 45 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 47, 49, 61, and 62 also patentably distinguish over the cited references.

As also discussed above in the arguments for patentability under 35 USC §102, claim 66 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Mine. Claims 70 and 82 depend from claim 66 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 70 and 82 also patentably distinguish over the cited references.

As also discussed above in the arguments for patentability under 35 USC §102, claim 84 patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Mine. Claims 88 and 91 depend from claim 84 and include all of the features of that claim plus additional features which are not taught or suggested by the cited references. Thus, it is respectfully submitted that claims 88 and 91 also patentably distinguish over the cited references.

IN ITEMS 21-22 ON PAGES 28-29 THE EXAMINER REJECTED CLAIMS 50 AND 71 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL IN VIEW OF KOZUKA.

Claim 50 depends from claim 45, and claim 71 depends from claim 66. Claims 45 and 66 patentably distinguish over Verbakel, and the deficiencies of Verbakel are not cured by Kozuka as previously noted. Therefore, it is respectfully submitted that claims 50 and 71 also patentably distinguish over the cited references.

IN ITEMS 23-24 ON PAGES 29-30 THE EXAMINER REJECTED CLAIMS 60, 78, 80 AND 89 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL IN VIEW OF KOZUKA.

Claim 60 depends from claim 45, claims 78 and 80 depend from claim 66, and claim 89 depends from claim 84. Claims 45, 66, and 84 patentably distinguish over Verbakel, and the deficiencies of Verbakel are not cured by Kozuka. Therefore, it is respectfully submitted that claims 60, 78, 80, and 89 also patentably distinguish over the cited references.

IN ITEM 25 ON PAGES 30-31 THE EXAMINER REJECTED CLAIM 69 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER VERBAKEL IN VIEW OF MINE.

Claim 69 depends from claim 66, which patentably distinguishes over Verbakel. Further, the deficiencies of Verbakel are not cured by Mine. Therefore, it is respectfully submitted that claim 69 also patentably distinguishes over the cited references.

IN ITEM 26 ON PAGES 31-32 THE EXAMINER REJECTED CLAIM 93 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER U.S. PATENT NO. 5,537,387, ISSUED

TO ANDO ET AL. (HEREINAFTER "ANDO") IN VIEW OF KOZUKA.

As a general matter, in order to establish a prima facie obviousness rejection, the Examiner needs to provide both the existence of individual elements corresponding to the recited limitations, and a motivation to combine the individual elements in order to create the recited invention. Both the individual elements and the motivation need to be shown to have existed in the prior art. Should the Examiner fail to provide evidence that either one of the individual elements or the motivation does not exist in the prior art, then the Examiner has not provided sufficient evidence to maintain a prima facie obviousness rejection of the claim. MPEP 2143.03. Thus, the burden is initially on the Examiner to provide evidence as to why one of ordinary skill in the art would have been motivated to combine the individual elements to create the recited invention, and to demonstrate that this evidence existed in the prior art. MPEP 2143.01.

As an example, MPEP 2143.01 refers to In re Koltzab, 55 USPQ2d 1313 (Fed. Cir. 2000). In In re Koltzab, the Federal Circuit agreed with the Patent Office and the Examiner that the prior art, as a whole, disclosed each of the individual elements of the recited invention, which was an injection molding machine. However, the Federal Circuit held that "a rejection [for obviousness] cannot be predicated on the mere identification in [one of the prior art references] of individual components of the claimed limitations." Instead, the Federal Circuit held that **"particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."** Id. at 1317. (Emphasis added). As such, in order to establish a prima facie obviousness rejection of a claim, the Examiner needs to both provide this particular evidence of the motivation to make the combination, and show that this evidence existed in the prior art. MPEP 2141.03.

Such evidenced motivation is completely missing from the Office Action. No motivation to combine the cited references is provided other than conclusory statements that "[i]n order to improve the access time and storage capacity Ando's recording medium, it would have been obvious...., because the replaced DVD type recording medium has advantages of fast access time and large storage capacity over the original CD type recording medium."

Thus, as pointed out in In re Koltzab, the mere identification in one of the prior art references of individual components of the claimed limitations is not sufficient to establish a prima facie case of obviousness. Further, the Examiner has not responded to the arguments made by Applicant previously that no motivation is provided through a conclusory statement.

To reiterate, Ando discloses a magneto-optical disc having a read-only area and a

magneto-optical writable area located outside the read-only area. A magneto-optical disc such as the one discussed in Ando is housed in a protective cartridge to protect the disc, with a sliding access cover on the protective cartridge so that an apparatus to read/write data from/to the magneto-optical disc must be equipped to both accommodate the protective cartridge as well as open the sliding access cover to gain access to the magneto-optical disc. In other words, the magneto-optical disc is used in a very different manner, and with very different devices from the DVD type discs discussed in Kozuka. As a DVD and a magneto-optical disc are two different areas of technology requiring different equipment to either read data from or write data to the respective discs, the Applicant respectfully submits that there is no motivation to combine the two cited references. The Examiner has provided no reason that one skilled in the art absent any knowledge of the present invention would make the combination set forth. Further, no straight substitution of components is possible with the combination suggested and as recited in MPEP § 2143.01, a proposed modification cannot change the principle of operation of a reference. Because DVD's and magnetic media operate based on different principles of operation there is no motivation to combine Ando and Kozuka.

Therefore, even if the two references combined did teach or suggest all of the features recited in the present application, and the Applicant respectfully submits that they do not, there is no motivation to combine the two references to achieve the features recited in the present application, and the Applicant respectfully requests the §103(a) rejection of claim 93 be withdrawn.

IN ITEM 27 ON PAGES 33-34 THE EXAMINER REJECTED CLAIM 94 UNDER 35 U.S.C. §103(A) AS BEING UNPATENTABLE OVER ANDO IN VIEW OF KOZUKA AND MINE.

Claim 94 depends from claim 93 and includes all of the features of that claim plus additional features which are not taught or suggested by Ando. Further, the deficiencies of Ando are not cured by Mine and/or Kozuka. Therefore, it is respectfully submitted that claim 94 also patentably distinguishes over the cited references.

ALLOWABLE SUBJECT MATTER

In item 28 on pages 34 the Examiner objected to claims 17, 18, 20, 22, 55-57, 76, 77, 79, 81 and 83 as being dependent upon rejected base claims, but indicated that they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, these claims have been rewritten as new claims 95-

106, with the independent claims incorporating all of the limitations of the base and intervening claims.

SUMMARY

Applicant submits that this Amendment After Final Rejection clearly places the subject application in condition for allowance. This Amendment was not earlier presented, because Applicants believed that the prior Amendment placed the subject application in condition for allowance. Accordingly, entry of the instant Amendment as an earnest attempt to advance prosecution and reduce the number of issues is requested under 37 C.F.R. § 1.116.

Applicant believes that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.


There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Response, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 9/30/2005

By: 
Steven W. Crabb
Registration No. 46,092

1400 Eye St., NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510